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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/752,257	01/06/2004	Mark Girard	10123/04001	4003
7590 04/08/2008				
Patrick J. Fay, Esq. FAY KAPLUN & MARCIN, LLP Suite 702 150 Broadway New York, NY 10038				
EXAMINER				
GRAY, PHILLIP A				
ART UNIT		PAPER NUMBER		
3767				
MAIL DATE		DELIVERY MODE		
04/08/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/752,257

Applicant(s)

GIRARD ET AL.

Examiner

Phillip Gray

Art Unit

3767

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1/6/04 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1448 or PTO-889)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Inventor's Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This office action is in response to applicant's communication of 12/26/2007. Currently amended claims 1-18 are pending and stand rejected below.

Response to Arguments

Applicant's arguments filed 12/26/2007 have been fully considered but they are not persuasive. Applicant argues that figures 10 and 11 of Johnson do not show the "chamfer portion". Examiner is of the position that the rounded surface (122) is a chamfer portion and it is "within the housing" (although not fully completely enclosed by the housing) and further this rounded surface would be fully capable of "redirecting a portion of the force to compress the operative surface in a direction substantially parallel to the annular surface". It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed (i.e. redirecting of force) does not differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitations. Further the prior art need not disclose the claimed invention *in haec verba*. Where there is reason to believe that a functional limitation (i.e. redirecting of force) asserted to be critical to establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic in the prior art (Johnson and prior art), applicant may be required to prove that the subject matter shown in the prior art does not possess the characteristic relied upon (redirecting of force).

The elements disclosed in Johnson and the prior art of record are fully capable of satisfying all structural, functional, spatial, and operational limitations in the amended

claims, as currently written, and the rejection is made and proper. See rejection discussion below.

Claim Rejections - 35 USC § 102 (2nd)

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson et al. (U.S. Patent Number 5,989,216).

Johnson discloses an implantable infusion device with an access port (see figures 10 and 11). Johnson discloses an access port (as shown in figures 10 and 11) comprises a housing (130,132, 120 for example) with a first opening (area near 129), a septum (122) mounted with the housing, and attachment portion (lower unnumbered portion of septum 122) with a chamfer (angled cut in 122), and a second opening (unnumbered area near 150) that can connect to a catheter. Further Johnson discloses a septum seat (area which septum rest on) formed by a housing and an attachment portion (as in figures 10 and 11), which compresses the septum between. Johnson discloses a chamfer attachment portion that comprises a least one surface angled relative to the operative surface that forms a 45-degree angle and a stepped surface (angled cut between top half of septum and bottom portion of septum). Further the Johnson patent discloses a chamfer attachment portion comprising a curved fillet

(curved portion extending from the top operative surface of 122 to the lower attachment/annular surface) with a substantially constant radius of curvature and an annular portion abutting a septum seat of the housing (area that 122 sits near element 137). Johnson discloses a substantial planar compressed membrane operative surface (top area of 122) (that permits penetration and reseal by a needle) overlying the first opening, with a dimension greater than the first opening dimension. Further Johnson discloses that the chamfered attachment portion redirects a portion of the force to compress the outer surface and is subject to a force oriented substantially perpendicular to the plane of the outer surface (see paragraphs beginning at column 4 through column 9). Johnson also discloses that the operative surface is formed of a flexible polymeric material (see paragraphs beginning at column 6 line 20-63).

Concerning the amended claims 1, 4, 9, and 12, examiner is defining "an annular surface" as shaped like or forming a ring and "extending radially" as "of, like, or pertaining to a radius or a ray". Under this reading of the claims as currently amended, Johnson prior art discloses does disclose "an annular surface extending radially beyond a periphery of the operative surface and separated from the operative surface in a direction substantially perpendicular to the annular surface, the annular surface being coupled to the operative surface by the chamfer" and the "operative surface in a direction substantially parallel to the annular surface" (see figure 10-11). It is the examiners position that the housing, septum, annular surface, and attachment portion are fully capable of satisfying all structural, functional, operational, and spatial

limitations. The current amended claim limitations do not overcome and distinguish over the prior art of record.

Claims 1 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Wiita et al. (U.S. Patent Number 4,772,270), or Bark (U.S. Patent Number 4,904,241) alone. For the same reasons as stated in the above rejections, Wiita or Bark each disclose a septum with an operative surface (Wiita 70, Bark 34), a chamfer portion (Wiita 24, Bark near 36), and annular/attachment portion (Wiita near 72, Bark near 18). The elements disclosed in Wiita and Bark are fully capable of satisfying all structural, functional, spatial, and operational limitations in the amended claims, as currently written, and the rejection is made.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phillip Gray whose telephone number is (571)272-7180. The examiner can normally be reached on Monday through Friday, 8:30 a.m. to 4:30 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Simons can be reached on (571) 272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PAG
/Kevin C. Simons/
Supervisory Patent Examiner, Art Unit 3767

